



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/659,517

09/11/2003

Mamoud Sadre

3614

7590
Mamoud Sadre
Unit # 203
165 Tremont Street
Boston, MA 02111

07/08/2010

EXAMINER

ROBERTSON, DAVID

ART UNIT

PAPER NUMBER

2121

MAIL DATE

DELIVERY MODE

07/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/659,517	Applicant(s) SADRE, MAMOUD	
	Examiner Dave Robertson	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a Non-final office action in response to the Amendment received March 19, 2010. Claims 1-15 are pending.

Pro Se Applicant/Inventor

2. An examination of this application and application history reveals that applicant is not fully familiar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Because amendments and remarks on the record including examiner interviews conducted thus far and in ongoing prosecution may adversely affect any rights secured by such patent, Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution.

The Office cannot aid in selecting an attorney or agent. A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Response to Amendment

3. Claims submitted March 19, 2010 refer to a "last set of claims...submitted in response to [an office action] of July 2, 2009 without any changes." However, the last complete (and compliant) set of claims received from Applicant was received by the office on May 20, 2009, and there was no office action mailed July 2, 2009 (an Examiner's Interview Summary is not an office action). To ensure a clear record, official dates of receipt must be used in referring to papers received and mailed to and from Applicant. The official date of an office action is the mailing date. For example, Applicant's submissions on March 19, 2010 and December 12, 2009 refer to a previous office action of September 9, 2009. However, the office action previous the December 12, 2009 was mailed October 27, 2009, and an office action of record was mailed September 9, 2000. The correct date in all communications to the office is the official date of physical receipt by the office, or the official mailing date as per 37 C.F.R. § 1.8 and §1.10. Examiner also notes that the claims filed May 20, 2009, have arguments interspersed between the claims and responding to the prior office action as well as remarks generally as to the merits of the invention. Applicant is requested in response to file amendments with a complete set of claims as proscribed in 37 C.F.R. § 1.75 and 37 C.F.R § 1.121 ("Manner of making amendments in applications"). For the purposes of examination herein, claims identified as "Clean copy" presented in Section D) of the Amendment of 3/19/2010 (pages 6 and 7) will be considered as the status of claims to date. Applicant is requested to use the above referenced procedures in further communications.

Response to Arguments

4. Applicant's Remarks filed December 1 and December 4, 2009, do not fully or substantively address all rejections made by the Examiner in the office action of October 27, 2009, namely the rejections made under 35 U.S.C. 112, 1st paragraph (see OA of 10/27/2009, page 2) and rejections under 35 U.S.C. 103.

Mere assertions of support that "the specification details a step-by-step approach...accompanied by respective...drawings, the concept is exemplified" is not sufficient to show adequate enablement and written description (see Remarks of 12/4/2009 pgs 3-4).

Applicant further argues (Remarks, 12/4/2009, pgs. 4-5) differences between the Applicant's invention and the prior art. However, while differences between the manner of making or using, or differences or advantages to the invention over the prior art may be appreciated, Applicant does not expressly identify a particular difference in the invention *as claimed* in distinction over the prior art applied. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Notwithstanding the above, because the invention as claimed is indefinite with respect to 35 U.S.C. 112, 2nd paragraph (as below), and because such indefiniteness as to the metes and bounds of the claims preclude examination on the merits and as well to determining adequacy and enablement of the written description, the rejections of the prior office action are presently withdrawn.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites: **A system methodology and procedure that extracts..., containing...means for building...; means for generating...; means for developing...; means for compiling...; and means for storing, comparing, unifying, and updating...** However, it is unclear what statutory class of invention is being claimed and therefore indefinite as to the scope of the claims presented for examination. Claims 2-15 depend from claim 1 and are similarly deficient as follows:

Under 35 U.S.C. 101, the basis for patent eligibility for inventions, inventions may be claimed as a “process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” A *system* is a machine or apparatus, while a *procedure* is a series of steps of acts in the performing of a process, and a *methodology* is a conceptual framework for problem solving. Because Applicant has not claimed any particular structure for a system, or any series of acts of a procedure or process, and because Applicant may additionally or alternatively be claiming the abstract idea of a methodology, it cannot be determined which statutory class Applicant is claiming as the invention and therefore the claims are indefinite.

Art Unit: 2121

7. Claims 1-15 are further rejected under 35 USC § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites: **A system methodology and procedure that extracts..., containing...means for building...; means for generating...; means for developing...; means for compiling...; and means for storing, comparing, unifying, and updating...**

The limitations invoke 35 USC § 112, ¶ 6 because each limitations meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase “means for” or “step for” (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. “If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.” In *re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general

Art Unit: 2121

purpose computer. Aristocrat Technologies, Inc. v. International Game Technology, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. Aristocrat, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function, however, in conjunction with the indefiniteness detailed above under 35 U.S.C. 112, 2nd paragraph, it is not apparent what means are proscribed by the *system methodology and procedure...* as claimed.

Applicant is requested on response to indicate what portions of the specification and drawings disclose sufficient corresponding structure, material or acts for performing the claimed function of each limitation.

Art Unit: 2121

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-15 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions:

An invention is statutory subject matter if the invention: a) falls into one of the statutory classes of invention (process, machine, manufacture, or composition of matter); b) is useful (has specific, substantial, and credible utility); c) is not a judicially created exception to patentable subject matter (law of nature, abstract idea, or natural phenomenon) without practical application; and d) is a practical application which does not preempt all uses of a judicially created exception to patentable subject matter. See MPEP [r5] § 2106 Patent Subject Matter Eligibility Part IV.

10. In the present case, claims 1-15 encompass an abstract idea, *a methodology... a judicial exception to patentable subject matter*. Claims encompassing both statutory and non-statutory subject matter are non-statutory. Therefore, even if disclosing *structure* for the recited means of claim 1, that claim 1 is sufficiently indefinite (as above under 35 U.S.C. 112, 2nd paragraph) to also encompass a conceptual framework (a methodology), claim 1 may be broadly interpreted as encompassing an abstract idea and is therefore ineligible for patenting under 35 U.S.C. 101.

Claims 2-15 depend from claim 1 and are similarly deficient.

Conclusion

11. Because it cannot be precisely determined what statutory class of invention is being claimed, examination on the merits at this time is precluded. However, Examiner recognizes and appreciates sufficient detail in the disclosure to warrant amendment to the claims to clarify the invention for the purposes of examination on the merits, and invites Applicant to request an interview with the Examiner upon receipt or in due course of response to this office action.

12. Applicant is further apprised of the prior art made of record and listed on the attached PTO Form 892. The cited prior art is not presently relied upon but is considered pertinent to applicant's disclosure and may be relied upon as prior art in a future office action. Applicant is invited to review such prior art in preparation for any interview or subsequent response.

Art Unit: 2121

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is (571)272-8220. The examiner can normally be reached on 9 am to 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dave Robertson/
Examiner, Art Unit 2121